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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,206	07/06/2001	Takahiro Koga	2000-205779US	3583

30743 7590 06/06/2006

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EXAMINER

BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/899,206

Applicant(s)

KOGA ET AL.

Examiner

Namrata Boveja

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,13,14,20,21 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,13,14,20,21 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 03/14/2006.
2. Claims 1, 2, 13, 14, 20, 21, and 26-28 are presented for examination.
3. Amendments to the elected claims, 1, 2, 13, 14, 20, and 21, as made by the applicant on 03/14/2006 have been entered and considered. Newly added claims 26-33 are also considered.
4. Claims 3-12, 15-19, and 22-25, teach the use of one or more transfer paths, receiving terminals, and users. Claims 1, 2, 13, 14, 20, 21, and 26-33 do not teach the use of one or more transfer paths and receiving terminals for more than one user and therefore these claims disclose a distinct invention from the non-elected claims. Therefore, the originally held restriction requirement is maintained.
5. Prosecution on the merits of this application is reopened on claims 1, 2, 13, 14, 20, 21, and 26-33 considered unpatentable for the reasons indicated below: the claimed invention is obvious in view of Bendinelli et al Patent Number 6,061,719 and Grapes Patent Number 6,446,130.

Claim Rejections - 35 USC § 112

The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

(A) the claims must set forth the subject matter that applicants regard as their invention; and

(B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

6. Claims 1, 13, 20, and 30 are rejected under 35 U.S.C. 112.

Art Unit: 3622

Claim 1 recites "second information providing means." There is insufficient antecedent basis for this limitation in the claim, since the second information providing means was not previously recited.

7. Claims 1, 13, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 1 recites "wherein in case of transmitting said second information to said at least one information receiving terminal, said information providing means transmits said second information addressed to said at least one information receiving terminal, said second information having been prepared for said customer corresponding to customer information relating to said customer, and wherein simultaneously said first information transfer path, which is used in case that said first information is transmitted and received between said information providing means and said at least one information receiving terminal, and said second information transfer path, which is used in case that said second information is transmitted and received between said information providing means and said at least one information receiving terminal, are different."

Therefore, no specific steps are claimed. Additionally, it is unclear if the second information is transmitted twice to the receiving terminal. Furthermore, the use of terms "wherein in case of", "used in case", and "received between" render the claim indefinite, because it is unclear if what is recited following these terms is actually completed. Also, the claims recite, "said second information having been prepared for a customer corresponding to customer information relating to

Art Unit: 3622

said customer." It is unclear what this means. It is interpreted to mean that the second information is prepared for a customer. Therefore, it is unclear what is the applicant claiming. For the purpose of claim examination, claims 1, 13, and 20 are addressed for the portion excluding the portion in the quotes above, since this part of the claim is not given any weight, as it cannot be understood in the present form.

8. Claims 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claim recites "in case that said first information". The use of terms "in case" render the claim indefinite, because it is unclear if what is recited following these terms is actually completed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. **Disclaimer:** Claims 1, 13, and 20 were found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.

Claims 1, 2, 13, 14, 20, 21, and 26-28, are rejected under 102(a) as being anticipated by Bendinelli et al (Patent Number 6,061,719 hereinafter Bendinelli).

Art Unit: 3622

In reference to claims 1, 13, and 20, Bendinelli teaches an information providing method, system, and recording medium comprising: information providing means of delivering first information including a pre-determined program or advertisement *via a first information transfer path (i.e. television program sent via an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13)* and second information including additional information relating to said first information *via a second information transfer path (i.e. an extracted URL received from the set top box which includes an internal telephone line modem, a cable modem, or another device for establishing a connection with a network) (col. 5 lines 19-32 and col. 5 lines 58-col. 6 lines 11)*; and at least one information receiving terminal for a customer that receives said first information and said second information *via said first and second information transfer paths respectively (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11)*.

10. In reference to claims 2, 14, and 21, Bendinelli teaches an information providing method, system, and recording medium comprising: first information providing means that delivers via a first information transfer path first information including a pre-determined program and advertisement *(i.e. television program sent via an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13)*; second information providing means that delivers via a second information transfer path second information including detailed information relating to said first information *(i.e. an extracted URL received from the set top box which includes an internal telephone line modem, a cable modem, or another device for*

Art Unit: 3622

establishing a connection with a network) (col. 5 lines 19-32 and col. 5 lines 58-col. 6 lines 11); and an at least one information receiving terminal for a customer that receives said first information via said first information transfer path and receives said second information via said second information transfer path (i.e. a television or computer) (col. 5 lines 33-40 and col. 5 lines 67 to col. 6 lines 11), wherein said second information providing means transmits said second information addressed to said at least one information receiving terminal (i.e. a webpage is transmitted to the computer) (col. 3 lines 57 to col. 4 lines 8), said second information having been prepared for a said customer corresponding to customer information relating to said customer (i.e. customer information can include whether the user has selected to continue the display a URL) (col. 4 lines 37-col. 5 lines 6).

11. *In reference to claim 26, Bendinelli teaches the information providing system, wherein the first information providing means is a broadcasting system (i.e. an antenna, a cable network, or a satellite receiver) (col. 5 lines 7-13) and said second information providing means is an information management center (i.e. a network) (col. 3 lines 57-col. 4 lines 8 and col. 5 lines 63 to col. 6 lines 11).*

12. *In reference to claim 27, Bendinelli teaches the information providing system, wherein the first information transfer path is a wireless transfer path (i.e. a satellite receiver) (col. 5 lines 7-13) and the second information transfer path is a network (col. 3 lines 57-col. 4 lines 8 and col. 5 lines 63 to col. 6 lines 11).*

13. *In reference to claim 28, Bendinelli teaches the information providing system, wherein said second information received by said at least one receiving*

Art Unit: 3622

terminal via said second information transfer path is in response to an input by said customer (i.e. the viewer selects to continually display a URL and turns off the ongoing display of transmitted URLs) (col. 4 lines 44-col. 5 lines 6 and Figure 2).

14. *In reference to claim 31, Bendinelli teaches the information providing system further comprising: information management means for managing communication information indicating that said first information was previewed by said customer (i.e. user response to advertisements for continuous display of a given advertisement) (col. 1 lines 63-col. 2 lines 5 and col. 4 lines 57-67); and information analysis means for executing a collection and analysis process for said communication information to obtain an analysis result on a preview situation of said first information, which is to be offered to a provider of said first information (i.e. analyzing that the user decided to view a given advertisement by selecting the option for continuous display) (col. 1 lines 63-col. 2 lines 5, col. 4 lines 57-67, and col. 5 lines 50-57).*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. *Claims 29-33 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Bendinelli in view of Grapes.*

Art Unit: 3622

In reference to claim 29, Bendinelli teaches the information providing system (col. 3 lines 57-col. 4 lines 8, col. 5 lines 7-13, and col. 5 lines 63 to col. 6 lines 11). Bendinelli does not teach the system comprising evaluation means for making an evaluation for rewarding said customer responding via said second information transfer path to first information received via said first information transfer path. Grapes teaches evaluation means for making an evaluation for rewarding said customer responding via said second information transfer path to first information received via said first information transfer path (i.e. data is evaluated regarding customer and transaction history and coupons are issued to influence purchasing) (abstract, col. 8 lines 13-16, col. 9 lines 1-14, col. 14 lines 41-44 and 51-53, and col. 15 lines 14-18). It would have been obvious to modify Bendinelli to include evaluation means for making an evaluation for rewarding said customer responding via said second information transfer path to first information received via said first information transfer path in order to enable advertisers to obtain direct customer feedback regarding the effectiveness of their advertising as indicated in one way by purchases made by the user of the advertised products.

16. **Disclaimer:** *Claim 30 was found to be deficient under U.S.C. 112 second paragraph. To the extent the claimed invention was understood, the following art was applied.*

In reference to claim 30, Bendinelli teaches the information providing system (col. 3 lines 57-col. 4 lines 8, col. 5 lines 7-13, and col. 5 lines 63 to col. 6 lines 11). Bendinelli does not teach the system wherein, in case that first

Art Unit: 3622

information includes advertising information, said evaluation means makes an evaluation for rewarding said customer responding to a contribution degree to commercial transaction achievements relating to products or services as an object of an advertisement. Grapes teaches the system wherein, in case that first information includes advertising information, said evaluation means makes an evaluation for rewarding said customer responding to a contribution degree to commercial transaction achievements relating to products or services as an object of an advertisement (i.e. customer is given incentives to influence the purchase of a product) (col. 3 lines 41-48 and 56-65 and col. 15 lines 14-18). It would have been obvious to modify Bendinelli to include evaluation means for making an evaluation for rewarding said customer responding to a contribution degree to commercial transaction achievements relating to products or services as an object of an advertisement to enable advertisers to provide better targeted advertising to customers to influence purchasing done by the customers by offering incentives at the time of purchase.

17. *In reference to claim 32, Bendinelli teaches the information providing system (col. 3 lines 57-col. 4 lines 8, col. 5 lines 7-13, and col. 5 lines 63 to col. 6 lines 11). Bendinelli does not teach the system wherein said information analysis means executes a collection and analysis process for said communication information based on customer information. Grapes teaches the system wherein said information analysis means executes a collection and analysis process for said communication information based on customer information (i.e. customer information is collected and used by the advertisers) (col. 14 lines 42-44). It*

Art Unit: 3622

would have been obvious to modify Bendinelli to include information analysis means to execute a collection and analysis process for said communication information based on customer information to enable advertisers to evaluate and analyze customers and target markets.

18. *In reference to claim 32, Bendinelli teaches the information providing system (col. 3 lines 57-col. 4 lines 8, col. 5 lines 7-13, and col. 5 lines 63 to col. 6 lines 11). Bendinelli does not teach the system wherein said customer information includes at least one of a name, a race, a nationality, sex, an address, an age, and an occupation. Grapes teaches customer information (col. 14 lines 42-44). Grapes does not specifically recite the customer information includes at least one of a name, a race, a nationality, sex, an address, an age, and an occupation, but this is inherent in Grapes invention, since Grapes discusses the use of a credit card payment method and validating the credit card, and to validate the credit card, customer name is definitely required and additional information such as age and address may also be required (col. 14 lines 58 to col. 15 lines 10). It would have been obvious to modify Bendinelli to include customer information including at least one of a name, a race, a nationality, sex, an address, an age, and an occupation to enable advertisers to evaluate and analyze customers at an individual level.*

Point of Contact

Any inquiry concerning this communication or earlier communications from

Art Unit: 3622

the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

May 26th, 2006
RETTA YEHDEGA
PRIMARY EXAMINER